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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,981	05/31/2002	Carson Thomas	112210XZ (GEMS0138PUS)	3813
61604 7590 12/19/2006 PETER VOGEL GE HEALTHCARE 3000 N. GRANDVIEW BLVD., SN-477 WAUKESHA, WI 53188			EXAMINER PASS, NATALIE	
			ART UNIT 3626	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/19/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/063,981

Applicant(s)

THOMAS ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Notice to Applicant

1. This communication is in response to the amendment filed 29 September 2006. Claims 1, 3, 5-7, 10-11, 14, 17, 19-21 have been amended. Claim 22 has been newly added. Claims 12-13 have been cancelled. Claims 1-11, 14-22 remain pending.

Claim Rejections - 35 USC § 112

2. The rejection of claims 19 and 20 under 35 U.S.C. 112, second paragraph, for being indefinite is hereby withdrawn due to the amendment filed 29 September 2006.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 1-3, 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Zubeldia et al., United States Patent Number 6, 397, 224 for substantially the same reasons given in the previous Office Action (paper number 20060615). Further reasons appear hereinbelow.

(A) Claim 17 has been amended to include the recitation of

- ♦ "creating a patient file from a patient file development network," in line 2;
- ♦ "transferring said patient file from said patient file development network to a primary care network," in lines 3-4;
- ♦ "transferring said patient file from said primary care network to an anonymization network," in lines 5-6; and
- ♦ "storing said anonymous file in an anonymous file storage element," in line 14.

As per these new limitations, Zubeldia teaches a method as analyzed and discussed in the previous Office Action (paper number 20060615), further comprising

creating a patient file from a patient file development network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-33);

transferring said patient file from said patient file development network to a primary care network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9);

transferring said patient file from said primary care network to an anonymization network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9); and

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storing said anonymous file in an anonymous file storage element (Zubeldia; Figure 2, Items 56, 82, column 5, lines 26-33, column 7, lines 49-54, column 10, line 64 to column 11, line 3).

The remainder of claim 17 is rejected for the same reasons given in the prior Office Action (paper number 20060615, section 5, page 3), and incorporated herein.

(B) Amended apparatus claims 1, 3, repeat the subject matter of claims 17, 21, respectively, as a set of elements rather than a series of steps. As the underlying processes of amended claims 17, 21 have been shown to be fully disclosed by the teachings of Zubeldia in the above rejections of amended claims 17, 21 it is readily apparent that the system disclosed by Zubeldia includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 17, 21, and incorporated herein.

(C) As per the amendments to claims 19-21, these appear to have been made merely to correct minor typographical or grammatical errors and to correct dependencies in the claims. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20060615, section 5, pages 3-4), and incorporated herein.

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(D) Claims 2, 18 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20060615, section 5, pages 3-4), and incorporated herein.

(E) As per newly added claim 22, Zubeldia teaches a method of anonymizing medical data comprising:

creating a patient file from a patient file development network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-33);

transferring said patient file from said patient file development network to an anonymization network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9);

extracting a patient identifier from said patient file (Zubeldia; column 5, lines 26-33);

searching a plurality of related pair identifiers contained in a pair list database for said patient identifier (Zubeldia; column 6, lines 54-56, column 6, line 66 to column 7, line 2);

retrieving an associated anonymous identifier paired to said patient identifier from one of said related pair identifiers (Zubeldia; column 7, lines 8-15);

replacing said patient identifier with said associated anonymous identifier to create an anonymous file (Zubeldia; column 3, lines 22-27); and

storing said anonymous file in an anonymous file storage element (Zubeldia; Figure 2, Items 56, 82, column 5, lines 26-33, column 7, lines 49-54, column 10, line 64 to column 11, line 3).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-11, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zubeldia et al., United States Patent Number 6, 397, 224 as applied to claims 1 and 3 above, and further in view of Leveque et al., United States Patent Application Publication Number 2002/0128860 for substantially the same reasons given in the previous Office Action (paper number 20060615). Further reasons appear hereinbelow.

(A) Claim 10 has been amended to include the recitation of

- ♦ "from said patient file development network and a second communications input for receiving said one or more patient files from said primary care network," in lines 9-11; and
- ♦ "wherein said one or more anonymous files are stored in an anonymous file storage element," in lines 17-18.

As per these new limitations, Zubeldia and Leveque teach an apparatus as analyzed and discussed in the previous Office Action (paper number 20060615), further comprising

communications input for receiving said one or more patient files from said patient file development network and a second communications input for receiving said one or more patient

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files from said primary care network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9); and

wherein said one or more anonymous files are stored in an anonymous file storage element (Zubeldia; Figure 2, Items 56, 82, column 5, lines 26-33, column 7, lines 49-54, column 10, line 64 to column 11, line 3).

The remainder of claim 10 is rejected for the same reasons given in the prior Office Action (paper number 20060615, section 7, pages 7-8), and incorporated herein.

The motivations for combining the respective teachings of Zubeldia and Leveque are as given in the rejection of claim 4 in the prior Office Action (paper number 20060615) and incorporated herein.

(B) Amended apparatus claims 6, 7, repeat the subject matter of amended claims 14, 10, respectively. As the underlying processes of amended claims 14, 10 have been shown to be disclosed by the teachings of Zubeldia and Leveque in the above rejections of amended claims 14, 10, it is readily apparent that the system disclosed by Zubeldia and Leveque includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 14, 10, and incorporated herein.

(C) As per the amendments to claims 5, 11, 14 these appear to have been made merely to correct minor typographical or grammatical errors and to correct dependencies in the claims. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the

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manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20060615, section 5, pages 3-4), and incorporated herein.

(D) Claims 4, 8-9, 15-16 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20060615, section 5, pages 3-4), and incorporated herein.

Response to Arguments

7. Applicant's arguments filed 29 September 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 29 September 2006.

(A) On page 9 of the response filed 29 September 2006 Applicant lists the amended, cancelled, and pending claims and discusses the rejection of claims 19 and 20 under 35 U.S.C. 112, second paragraph, with which Examiner is in substantial agreement, however Examiner notes 2 typographical errors on page 9, in that the pending claims should have been listed as claims 1-11, 14-22, and that in the last paragraph the amended claim should have been listed as claim 20 rather than claim 19.

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(B) At pages 10-12 of the 29 September 2006 response, Applicant argues that the claimed features of the application are not taught or suggested by the applied reference. In response, all of the limitations which Applicant disputes are missing in the applied reference, including the newly added features and the features discussed by Applicant in the amendment filed 29 September 2006, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of the applied references, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC §102 and 35 USC §103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20060615), and incorporated herein. In particular, Examiner notes that the limitations of creating a patient file from a patient file development network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-33); transferring said patient file from said patient file development network to a primary care network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9); transferring said patient file from said primary care network to an anonymization network (Zubeldia; column 3, line 63 to column 4, lines 4, column 4, lines 16-22, column 9, lines 16-23, column 10, lines 6-9); and storing said anonymous file in an anonymous file storage element (Zubeldia; Figure 2, Items 56, 82, column 5, lines 26-33, column 7, lines 49-54, column 10, line 64 to column 11, line 3) are taught by the applied references. Examiner interprets Zubeldia's teachings of "[t]he system bus 32 and a network backbone 36 may be regarded as data carriers. ... [...] ... the network 14 may comprise a single local area network (LAN), a wide area network (WAN), several adjoining networks, an intranet, an extranet, or as in the manner depicted, a system of interconnected networks such as the

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Internet 40. The individual computer workstations 12 may communicate [reads on “transfer files”] with each other over the backbone 36 and/or over the Internet 40 using various communication techniques. ... [...] ... In the case of the Internet 40, however, a layered communications protocol (i.e. TCP/IP) generally best enables communications between the differing networks 14 and computer workstations 12” (Zubeldia; Figure 1, column 4, line 56 to column 5, line 9) to be a form of transferring files between networks and Examiner interprets Zubeldia’s teachings of “a system 50 for anonymously linking a plurality of data records 52. The data records 52 may be stored within an input database 54 or other suitable location. The input database 54 may comprise, for example, a conventional relational database management system (RDBMS), such as one available from ORACLE.RTM., SYBASE.RTM., or the like. ... [...] ... In one embodiment, each data record 52 includes a plurality of identifying elements 56 for identifying an individual to whom the record 52 pertains. The identifying elements 56 may include, for example, a name, a birth date, an address, a ZIP code, a telephone number, a healthcare identifier, and the like” (Zubeldia; Figure 2, column 5, lines 16-31) and “[t]he system 50 may also include an identifying element removal module 78 and an anonymization code insertion module 80. In one embodiment, the identifying element removal module 78 removes the identifying elements 56 of the data record 52, resulting in an anonymized data record 82,” (Zubeldia; column 7, lines 49-54) to be a form of transferring files and storing said anonymous file in an anonymous file storage element.

As per Applicant’s argument at paragraph 4 of page 10 of the 29 September 2006 response the applied reference “clearly does not teach or suggest an anonymous file storage element for storing the one or more anonymous files” Examiner respectfully disagrees, and notes

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that in the disclosure, Applicant's "anonymous file storage element 64" (Specification, page 7, lines 5-6, and Figure 2, Item 64) teaches moving anonymized files into an element or folder. As per this teaching, Examiner interprets Zubeldia's teachings of "a system 50 for anonymously linking a plurality of data records 52. The data records 52 may be stored within an input database 54 or other suitable location. The input database 54 may comprise, for example, a conventional relational database management system (RDBMS), such as one available from ORACLE.RTM., SYBASE.RTM., or the like. ... [...] ... In one embodiment, each data record 52 includes a plurality of identifying elements 56 for identifying an individual to whom the record 52 pertains. The identifying elements 56 may include, for example, a name, a birth date, an address, a ZIP code, a telephone number, a healthcare identifier, and the like" (Zubeldia; Figure 2, column 5, lines 16-33) and "[t]he system 50 may also include an identifying element removal module 78 and an anonymization code insertion module 80. In one embodiment, the identifying element removal module 78 removes the identifying elements 56 of the data record 52, resulting in an anonymized data record 82," (Zubeldia; Figure 2, Items 56, 82, column 7, lines 49-54) and "[a]fter the anonymization codes 66 are stored, the identifying elements 56 of the record 52 may be removed using conventional techniques to generate an anonymized data record 82" (Zubeldia; column 10, lines 64-67) to be a form of storing said anonymous file in an anonymous file storage element.

As per Applicant's argument at the last paragraph of page 11 of the 29 September 2006 response regarding dependent claims 4-9 that the claimed features of the application are not taught or suggested by the applied references, Examiner notes that all of the limitations which Applicant disputes are missing in the applied reference, including the newly added features and

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the features discussed by Applicant in the amendment filed 29 September 2006, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of the applied references, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC §102 and 35 USC §103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20060615), and incorporated herein.

As per Applicant's argument at paragraph 1 of page 12 of the 29 September 2006 response regarding newly added limitations of independent claim 10, these features have been discussed earlier in this office action.

Conclusion

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

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For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

December 11, 2006


C. LUKE GILLIGAN
PATENT EXAMINER
Primary